REMARKS

Claims 1-15 are pending.

Claims 1, 8, 9 and 12 have been amended merely to clarify the claimed subject matter and to correct certain informalities. Accordingly, Applicants respectfully request substantive consideration of those amendments and allowance of all pending claims.

Prior Art Rejections

The office action maintained an earlier rejection of claims 1-7 as being anticipated by U.S. Patent No. 6,594,799 (Robertson et al.).

Essentially, the office action construed the newly added claim feature "the user terminal is adapted to allow the user to select a circuit device having any of a single-layer structure or a multi-layer structure" to require only that the user terminal *not prevent* a user from making the recited selection. Since the Robertson et al. patent does not appear to prevent a user from making such a selection, the office action rejected Applicants' argument that the newly added feature distinguishes the Robertson et al. patent.

Applicants have amended claim 1 to clarify that feature. Claim 1 now recites that the user terminal *enables* the user to select a circuit device having either a single-layer structure or a multi-layer structure. *Emphasis added.* Support for that amendment can be found, for example, on page 28, lines 8-17, which states "various modifications can be made without departing from the scope and sprit of the present invention. For example . . . it is further possible to employ a configuration in which the user can select a single-layer structure or a multi-layer structure when the user inputs conditions of the ISB circuit device from the user terminal 10." No new matter has been added. The Robertson et al. patent clearly does not enable a user to select a circuit device having either a single-layer structure or a multi-layer structure, as recited in claim 1.

As Applicants discussed in a previous office action response, the Robertson et al. patent merely discloses a multi-faceted portal site that allows connection over the Internet to end user systems and suppliers. Various tools and services are available through the portal site to

facilitate electronic design by engineers. Although the Robertson et al. patent discloses that the user may make various selections that are transmitted to the portal site, there is no disclosure or suggestion that the system is adapted to enable the user to select any of a single-layer structure or multi-layer structure, as recited in claim 1.

Claim 1 should be allowable for at least the foregoing reasons.

Claims 2-7 depend from claim 1 and, therefore, should be allowable for at least the same reasons as claim 1.

The office action also maintained an earlier rejection of claims 8-12 as being anticipated by the Robertson et al. patent.

Claim 8 has been amended in a manner similar to claim 1. In particular, claim 8 now recites that the terminal for the device manufacturer *enables* a user to select a circuit device having any of single-layer structure or a multi-layer structure. *Emphasis added.* As discussed above with respect to claim 1, the Robertson et al. patent neither discloses nor suggests that feature.

Claim 8 should be allowable for at least the foregoing reasons.

Claims 9-12 depend from claim 8 and, therefore, should be allowable for at least the same reasons as claim 8.

Non-Prior Art Issues

Claims 1-15 also were rejected under the first paragraph of 35 U.S.C. §112 because the newly added claim feature "the user terminal is adapted to allow the user to select a circuit device having any of a single-layer structure or a multi-layer structure." allegedly failed to comply with the written description requirement.

As discussed above, that feature has been amended to recite that "the user terminal ~~is adapted to allow~~ enables the user to select a circuit device having any of a single-layer structure or a multi-layer structure." Applicants submit that the foregoing feature does not violate the written description requirement because that feature was described in the specification in such a

way as to convey that the that the inventors had possession of the invention at the time the application was filed.

In particular, page 28, lines 8-17 of the specification states:

> A preferred embodiment of the present invention has been described. The present invention, however, is not limited to the described embodiment, and various modifications can be made without departing from the scope and spirit of the present invention.
>
> For example, as an ISB circuit device, in addition to a structure having a single-layer wiring layer, it is also possible to employ a structure having multi-layered wiring, and it is further possible to employ a configuration in which the user can select a single-layer structure or a multi-layer structure when the user inputs conditions of the ISB circuit device from the user terminal 10.

The foregoing statement clearly demonstrates that the inventors, at the time the application was filed, had possession of a user terminal (*e.g.*, user terminal 10) that enables a user to select a circuit device having any of a single-layer structure or a multi-layer structure. Indeed, that feature is clearly presented in the above passage as an exemplary modification of a preferred embodiment of the invention. Moreover, the above passage specifically states that the feature was intended to be included within the scope and spirit of the invention.

The office action stated that the above passage "is not a concrete recitation of function, since the Applicant presents it only as a 'possibility.'" However, it is not a violation of the written description requirement to use the phrase "it is further possible" to describe a feature that represents one of several possible modifications to a preferred embodiment of an invention. The mere use of "it is further possible" to describe such features does not mean that the Inventors did not have possession of that feature at the time of the application's filing.

Applicants request withdrawal of the 35 U.S.C. §112, paragraph 1 written description rejections.

The office action also indicated that claim 1 was not enabled allegedly because nothing in the specification provides support for how the newly added feature in claim 1 is accomplished.

As discussed above, the newly added feature has been amended to recite that "the user terminal ~~is adapted to~~ enables the user to select a circuit device having any of a single-layer

structure or a multi-layer structure." Applicants submit that a person of ordinary skill would have understood how to make and use the newly added claim feature for at least the following reasons.

First, the passage that is reproduced above in the section of this response discussing written description, clearly describes the newly added feature. Specifically, the above-referenced passage from the specification explains that "it is further possible to employ a configuration in which the user can select a single-layer structure or a multi-layer structure when the user inputs conditions of the ISB circuit device from the user terminal 10."

Additionally, the specification includes several references to the system enabling a user to make various selections. For example:

> The ISB server 16 provides [various] part data registered in the database 18 to the user terminal 10 to allow easier input of the conditions by the user by suitably *selecting* the necessary part data from the provided data.

Page 15, lines 7-10 (*Emphasis added*);

> . . . by registering, in the database 18, part data of the part manufacturers in advance and providing the part data to the user, it is possible to provide a wider *selection* of built-in parts to the user and facilitate and accelerate creation of the list.

Page 17, lines 5-9(*Emphasis added*); and

> It is also possible to employ a configuration in which the user can *select* whether or not they wish to obtain the "operation confirmation simulation on the web", and to then return evaluation results only when the user indicates their desire to obtain the simulation results.

Page 22, lines 13-17.

In addition, even if the above passages had not been included in the specification, a person of ordinary skill would have understood how a user might select various data at a computer user terminal.

The concept of enablement "permits resort to material outside of the specification . . . because it makes no sense to encumber the specification of a patent with all the knowledge of the past concerning how to make and use the claimed invention. One skilled in the art knows how to make and use a bolt, a wheel, a gear, a transistor, or a known chemical starting material. The specification would be of enormous and unnecessary length if one had to literally reinvent and describe the wheel." *Genentech, Inc. v. Novo Nordisk*, 108 F.3d 1361 (Fed. Cir. 1997).

There are a variety of ways that a user terminal might enable a user to select data. A person of ordinary skill would understand that.

Accordingly, Applicants request recognition that claim 1 is enabled.

The office action also indicated that the phrase "adapted to" in claims 1 and 8 allegedly lacked support in the specification.

That phrase has been deleted from claims 1 and 8.

The office action also indicated that claims 13 and 14 were not enabled allegedly because the supporting statements in the specification are not concrete recitations of function and because nothing in the instant specification provides support for how such a function is accomplished.

Claim 13, for example, recites that "the processor means of the server determines whether the circuit device is of a single layer structure or a multi-layer structure based on the condition or the circuit device data received from the user terminal." Claim 14 recites that "the processor means of the server determines whether the circuit is of single layer or structure or a multi-layer structure based on at least one of a size of external form, a heat discharging characteristic or a frequency characteristic received from the user terminal."

As the office action recognized, page 28, lines 18-22 of the specification clearly recites:

> The present invention . . . is not limited to the described embodiment, and various modifications can be made without departing from the scope and sprit of the present invention. For example. . . it is also possible for the ISB server 16 to

> automatically determine whether to employ a single-layer structure or a multi-layer structure based on the external size, thermal discharge characteristic, and frequency characteristic input by the user and design a pattern.

That passage provides clear support and clearly would have enabled a person to make and/or use the feature that is recited in claims 13 and 14.

The office action incorrectly alleges that the passage reproduced above "is not a concrete recitation of function, since Applicant presents it only as a 'possibility.'" However, there is no prohibition against finding support in a specification in a statement that presents a possible modification to a preferred embodiment of the disclosed invention. The passage reproduced above represents just that.

Additionally, the office action incorrectly alleges that the recited claim features lack support and enablement because nothing in the specification provides support for how such a function is actually accomplished. However, a person of ordinary skill, reading the above passage, would clearly understand how the recited features is accomplished. Additionally, claim 14 explains that the function may be accomplished by considering at least one of several factors (*e.g.*, a size of external form, a heat discharging characteristic or a frequency characteristic received from the user terminal).

Applicants request recognition that claims 13 and 14 are enabled and supported by the specification for at least the foregoing reasons.

The office action also rejected claims 1-15 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have amended the claims to correct those concerns identified in the office action. In particular:

> The phrases "is adapted to" and "allow the user to select" in claims 1 and 8 have been canceled.
>
> The phrase "allows the user to" has been changed to "enables the user to."

The phrase "is adapted for" in claim 12 has been changed to "enables."

The Examiner also objected to the drawings because they do not show every feature of the invention as recited in the claims.

Applicants submit that the existing drawings do sufficiently show the features recited in the claims. As to amended claim 1, the recited input means is part of a user terminal, which is clearly shown in FIG. 1. As to amended claim 8, the terminal for the device manufacturer is clearly shown in FIG. 1. As to claim 9, FIG. 11, for example, is a screenshot that clearly shows screen data enabling the user to make a selection. As to claims 13, 14 and 15, the server is clearly shown in FIG. 1. Accordingly, Applicants believe that the existing figures sufficiently illustrate the features recited in the claims.

Applicants request withdrawal of the drawing objections. If the Examiner is not persuaded to withdraw those objections, Applicants request that the Examiner specify exactly what additional drawings the Examiner believes might be necessary to overcome these objections.

Claims 13 and 14 were rejected as being unpatentable over the Robertson et al. patent in view of U.S. Patent No. 6,763,512 (Xing).

Claims 13 and 14 depend from claim 1, which recites a user terminal that enables a user to select a circuit device having any of a single-layer structure or a multi-layer structure. For the reasons discussed in detail above, the Robertson et al. patent does not disclose or suggest that feature. Nor does the Xing patent disclose or suggest that feature.

The Xing patent discloses a computer system 1 used in the design and manufacture of VLSI circuits. *See* FIG. 1 and Abstract. The computer system 1 includes a processor subsystem 2 with a VLSI circuit design module 6. The VLSI circuit design module provides the computer system 1 with VLSI circuit design functionality. When plural routing areas are defined by the VLSI circuit design module 6, the integrated circuit being designed is a multi-layer integrated circuit and each routing area comprises the surface of a respective layer of the multi-layer integrated circuit. Column 4, lines 13-18. The Xing patent lacks a user terminal that enables a

user to select a circuit device having any of a single-layer structure or a multi-layer structure, as recited in claim 1.

Claims 13 and 14 should be allowable for at least the foregoing reasons.

Claim 15 was rejected as unpatentable over the Robertson et al. patent in view of Applicant's admitted prior art (on pages 17-18 of the specification).

The Office Action acknowledges that the Robertson et al. patent does not disclose that a "processor means of the server provides to the user terminal rule data for creating pattern design data based on the condition and the circuit device data received from the user terminal." The Office Action, however, relies on the Applicant's statement that "techniques for designing a pattern from a circuit diagram and for designing a mask from a pattern are known" as a reason why someone of ordinary skill would modify the Robertson et al. patent to obtain the recited claim limitation. *See* Page 18, lines 2-4.

The mere fact that techniques for designing a pattern from a circuit diagram and for designing a mask from a pattern might be known does not, in any way, amount to a disclosure of a processor means of a server that provides to the user terminal rule data for creating pattern design data based on the condition and the circuit device data received from the user terminal, as recited in claim 15.

Claim 15 should be allowable for at least the foregoing reasons.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Enclosed is a $120 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 5/1/06

Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
Citigroup Center
52nd Floor
153 East 53rd Street
New York, New York 10022-4611
Telephone: (212) 765-5070
Facsimile: (212) 258-2291

30262559.doc